UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,226	06/11/2001	Jeff Mazereeuw	57761.000137	8540

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EXAMINER
WEST, JEFFREY R

ART UNIT	PAPER NUMBER
2857	

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

	Application No.	Applicant(s)
	09/877,226	MAZEREEUW ET AL.
Office Action Summary	Examiner	Art Unit
	Jeffrey R. West	2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *16 June 2003* .

2a) ☒ This action is **FINAL**.　　2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-22* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-22* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☒ The proposed drawing correction filed on *16 June 2003* is: a) ☒ approved b) ☐ disapproved by the Examiner.

　　If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a) ☐ All b) ☐ Some * c) ☐ None of:

　　　1. ☐ Certified copies of the priority documents have been received.

　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

　　a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1, 3-5, 10, 12, 14-16, and 21 are rejected under 35 U.S.C. 102(e) as

being anticipated by U.S. Patent No. 6,236,332 to Conkright et al.

Conkright discloses a control and monitoring system comprising monitoring

equipment (i.e. one or more remote units), operatively connected to a device such

as a utility system (column 1, lines 31-32), that measures the operating current of

the device (column 8, lines 18-20). Conkright discloses operatively connecting the

monitoring equipment to a host computer through a first communication network (i.e.

wireless service gateway with subscriber software) (column 3, lines 53-61) as well

as operatively connecting a remote customer interface terminal to the host computer

through the same wireless service gateway and subscriber software, or the Internet

(column 3, lines 22-34) wherein the remote customer interface receives notification

of operating conditions of the monitored utility device (column 3, lines 29-52 and

column 4, lines 43-54) as well as allows the user to control the monitored device

(column 3, lines 38-43 and column 6, lines 32-38). Conkright also discloses that the

host computer contains a server database that is connected to the communication

networks and accessible by the customer interface (column 3, lines 44-52 and

Figure 1).

Although not specifically disclosed, it is considered inherent that in order for the

customer subscriber to communicate with the host computer and server database

there must be some corresponding protocol at the host computer and therefore the

access to this protocol is implemented using an application service provider (see

FOLDOC: Free On-Line Dictionary of Computing, Definition of "application service

provider").

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Conkright et al. in view of U.S. Patent No. 5,406,495 to Hill.

As noted above, Conkright teaches all of the features of the claimed invention except for including monitoring equipment for measuring the voltage of the utility device.

Hill teaches a substation load distribution monitoring system comprising remote data units for sensing operating conditions of the power equipment (column 3, lines 20-29) including periodic voltage and current data (column 1, lines 48-55). Hill also teaches that the remote data units communicate with a host computer over a communication network to transfer measured data (column 3, lines 4-17).

It would have been obvious to one having ordinary skill in the art to modify the invention of Conkright to include monitoring equipment for measuring the voltage of the utility device, as taught by Hill, because Conkright teaches a system for use in a plurality systems including a system employing condition monitoring over an AC power line (column 7, lines 9-11) and Hill suggests that the combination would have provided an improved-accuracy and simplified method of remote monitoring in a power system (column 1, lines 7-15), and therefore provided higher protection, by monitoring the voltage and current rather than just the current (column 6, lines 48-66).

5. Claims 7-9 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conkright et al. in view of U.S. Patent No. 6,006,171 to Vines et al.

As noted above, Conkright teaches all of the features of the claimed invention except for including automatic reporting, maintenance scheduling, and administrative tracking programs in the customer interface device.

Vines teaches a dynamic maintenance management system comprising a monitoring and analysis process for sending and receiving process control data to and from sensors and devices over a communication bus (column 3, lines 33-37). Vines teaches sending this information to a DMM configurator that processes the information (column 3, lines 53-65) to automatically provide reports describing device operation, preventive maintenance schedules, and administrative tracking (i.e. creating work orders including worker assignment) (column 5, lines 17-29 and 50-61 and Figures 3-9).

It would have been obvious to one having ordinary skill in the art to modify the invention of Conkright to include automatic reporting, maintenance scheduling, and administrative tracking programs in the customer interface device, as taught by Vines, because Conkright does include presenting information to a worker for fixing a fault that has occurred (column 9, lines 15-34), and, as suggested by Vines, the combination would have provided more detailed information to allow an operator to make better informed decisions and devise proactive planning, increased performance and predictability of equipment and operations, reduced maintenance costs, improved reliability, and avoided costly failures (column 2, lines 12-31 and column 5, lines 30-34).

6. Claims 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conkright et al. in view of U.S. Patent No. 5,712,896 to Lee et al.

As noted above, Conkright teaches all of the features of the claimed invention except for including an expertise database.

Lee teaches a method for diagnosing a fault comprising software that is executed by a hardware function to maintain/repair operation the hardware (column 3, lines 1-4) wherein the state of a fault occurring is detected by either a hardware or software fault detection function (column 3, lines 5-12). Lee also teaches that a fault message is outputted from a switching system to a user via a fault diagnosis expert system and a user matching function (column 3, lines 21-23) that communicates, via an inference engine and a multimedia or graphic interface, questions to the user relating to the diagnosis using a corresponding knowledge base (i.e. database) (column 3, lines 36-38 and 41-49). Lee then teaches that after obtaining the answers to the questions, the diagnosis is completed and the expert system outputs a determination result of the fault diagnosis (column 4, line 56 to column 5, line 3).

It would have been obvious to one having ordinary skill in the art to modify the invention of Conkright to include an expertise database, as taught by Lee, because, as suggested by Lee, the combination would have provided a method for determining the type of fault that has occurred without the need of an expert in the field by providing interactive questions that guide the user through the process, and therefore allowed the diagnosis to be conducted immediately by an unskilled worker (column 1, lines 54-58).

7. Claims 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conkright et al. in view of Hill, Vines, Lee, and International Publication Number WO 00/04427 to Parsons.

As noted above, Conkright teaches many of the features of the claimed invention including specifying that the host computer connect to the customer interface through the Internet, but does not teach including monitoring equipment for measuring the voltage of the utility device, including automatic reporting, maintenance scheduling, and administrative tracking programs, including an expertise database, or specifying that the connection between the monitoring equipment and the host computer be the Internet.

Hill teaches a substation load distribution monitoring system comprising remote data units for sensing operating conditions of the power equipment (column 3, lines 20-29) including periodic voltage and current data (column 1, lines 48-55). Hill also teaches that the remote data units communicate with a host computer over a communication network to transfer measured data (column 3, lines 4-17).

Vines teaches a dynamic maintenance management system comprising a monitoring and analysis process for sending and receiving process control data to and from sensors and devices over a communication bus (column 3, lines 33-37). Vines teaches sending this information to a DMM configurator that processes the information (column 3, lines 53-65) to automatically provide reports describing device operation, preventive maintenance schedules, and administrative tracking

(i.e. creating work orders including worker assignment) (column 5, lines 17-29 and 50-61 and Figures 3-9).

Lee teaches a method for diagnosing a fault comprising software that is executed by a hardware function to maintain/repair operation the hardware (column 3, lines 1-4) wherein the state of a fault occurring is detected by either a hardware or software fault detection function (column 3, lines 5-12). Lee also teaches that a fault message is outputted from a switching system to a user via a fault diagnosis expert system and a user matching function (column 3, lines 21-23) that communicates, via an inference engine and a multimedia or graphic interface, questions to the user relating to the diagnosis using a corresponding knowledge base (i.e. database) (column 3, lines 36-38 and 41-49). Lee then teaches that after obtaining the answers to the questions, the diagnosis is completed and the expert system outputs a determination result of the fault diagnosis (column 4, line 56 to column 5, line 3).

Parsons teaches an internet utility interconnect means, and corresponding method, comprising operating a remote control and monitoring system that replicates data between a host computer located at a central server site and a set of automation nodes located at a remote site wherein the means to link the data collected for subsequent access is through the Internet (page 6, lines 15-32).

It would have been obvious to one having ordinary skill in the art to modify the invention of Conkright to include monitoring equipment for measuring the voltage of the utility device, as taught by Hill, because Conkright teaches a system for use in a plurality systems including a system employing condition monitoring over an AC

power line (column 7, lines 9-11) and Hill suggests that the combination would have provided an improved-accuracy and simplified method of remote monitoring in a power system (column 1, lines 7-15), and therefore provided higher protection, by monitoring the voltage and current rather than just the current (column 6, lines 48-66).

It would have been obvious to one having ordinary skill in the art to modify the invention of Conkright to include automatic reporting, maintenance scheduling, and administrative tracking programs in the customer interface device, as taught by Vines, because Conkright does include presenting information to a worker for fixing a fault that has occurred (column 9, lines 15-34), and, as suggested by Vines, the combination would have provided more detailed information to allow an operator to make better informed decisions and devise proactive planning, increased performance and predictability of equipment and operations, reduced maintenance costs, improved reliability, and avoided costly failures (column 2, lines 12-31 and column 5, lines 30-34).

It would have been obvious to one having ordinary skill in the art to modify the invention of Conkright to include an expertise database, as taught by Lee, because, as suggested by Lee, the combination would have provided a method for determining the type of fault that has occurred without the need of an expert in the field by providing interactive questions that guide the user through the process, and therefore allowed the diagnosis to be conducted immediately by an unskilled worker (column 1, lines 54-58).

Further, it would have been obvious to one having ordinary skill in the art to modify the invention of Conkright to include specifying that the connection between the monitoring equipment and the host computer be the Internet, as taught by Parson, because, as suggested by Parsons, the combination would have allowed the web server to be changed by authorized users and therefore enabled residents and other subscribers to conveniently turn on the connected devices whenever desired (page 4, lines 13-15 and page 8, lines 4-15).

Response to Arguments

8. Applicant's arguments filed 16 June 2003 have been fully considered but they are not persuasive.

Applicant argues that "the claimed use of an "application service provider" is in no way inherent in the teachings of Conkright" and further "the disclosure of *the customers 24 install the software on a personal computer (PC) at their home or office* would teach one of ordinary skill in the art away from the claimed application service provider, i.e., such arrangement goes against the need for an application service provider." Applicant further states "[t]he Office Action is essentially asserting that it is inherent that there be access to an application program across a network environment. Such access is clearly not inherent. Further, Conkright teaches directly against such arrangement by asserting that customers install the software on a personal computer at their home or office (column 3, line 37)" and "the assertion in the Office Action that it is considered "inherent that in order for the customer

subscriber to communicate with the host computer and server database there must be some corresponding protocol at the host computer" sounds of an Internet Service Provider (ISP). An Internet Service Provider, even if inherent in the system of Conkright, would be different from and in no way suggest the claimed "application service provider."

The Examiner asserts that the invention of Conkright specifically discloses that "[e]ach customer 24 is capable of communicating with the host computer 22 through the Internet 28, subscriber software 30, or through other communication media including, but not limited to, a direct dial-up phone line, facsimile, paging, e-mail or even human-to-human contact" and in order for the invention of Conkright to communicate through these means, specifically through facsimile, paging, or e-mail, there must inherently be some type of application service provider.

For example, it is well known in the art that in a paging system the paging provider has a server with associated applications for communication between the sending and receiving parties of a particular page. This server and associated application is the "application service provider." The instant specification further supports this paging system stating, "one or more servers 106 associated with an application service provider ("ASP") may be operably connected to the network 102, and may have uninterrupted communication with the substations 100, the client devices 104, or both, through the network 102" (page 3, lines 3-6) wherein "when a fault is detected, the servers 106 notify the appropriate members of the personnel operating the client devices 104 through network 102. In order to provide instant

notification of a fault the servers 106 may notify client devices 104, such as a pager 108 or cellular telephone" (page 10, lines 25-27). These passages further support the inherency that a pager system requires an associated "application service provider".

Further still, Howstuffworks, "How ASPs Work" defines an ASP as an application or service that is used by a particular business but owned by another business, which may or may not charge a fee or be Internet based. This definition defines the internet-based fax programs, e-mail providers, and pager systems disclosed by Conkright. Howstuffworks, "How ASPs Work" also broadly defines an ASP as a telephone connection because a telephone company provides an application/service to a company that desires to use the telephone system which it does not own. Therefore, the "dial up" communication connection disclosed by Conkright also meets this broad definition of an "application service provider"

As the foregoing describes, the invention of Conkright includes several communication methods that inherently require a separate application or service that is not owned by the customer or the host, thereby inherently requiring an associated "application service provider".

With respect to Applicant's argument that the "subscriber software" of Conkright teaches away from the use of an "application service provider" the Examiner maintains that the "subscriber software" is only one embodiment of the Conkright reference and that the embodiments of facsimile, e-mail, and pager communications would inherently include the use of an "application service provider." (See also, In re

Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971) --- Disclosed examples and

preferred embodiments do not constitute a teaching away from a broader disclosure

or nonpreferred embodiments).

Applicant then argues the combination of Conkright and the other cited

references as failing to teach the feature of the "application service provider." As

described above, the "application service provider" is an inherent feature of

Conkright rendering these arguments moot.

Applicant also argues that "the motivation set out in the Office Action for the

combination [of Conkright and Vines] is deficient" because the teachings of

Conkright "fall short of the assertions in the Office Action indicating that Conkright

teaches "presenting information to a worker for fixing a fault that has occurred."

Conkright simply does not support such teaching."

The Examiner maintains that Conkright discloses "when the back up power

supply battery 72 loses its charge, a signal is sent to the host computer 22 indicating

this failure . . . based on the notification signal, service personnel may be dispatched

to remedy the problem" and, as also admitted by Applicant, "after a failure of an

operating condition has been determined and located by the unit, such as an

inoperative bulb in the case of use of the system in a signboard application, a worker

or serviceman is sent to the site." The Examiner asserts that these cited passages

disclose presenting failure condition information to a worker (i.e. occurrence and

location) for fixing a fault that has occurred. Furthermore, motivation to combine the

references still exists because the combination, as suggested by Vines, would have

provided more detailed information to allow an operator to make better informed

decisions and devise proactive planning, increased performance and predictability of

equipment and operations, reduced maintenance costs, improved reliability, and

avoided costly failures (column 2, lines 12-31 and column 5, lines 30-34)

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

U.S. Patent Application Publication No. 2002/0057365 to Brown teaches a

monitoring or security device and methods comprising a monitoring unit that

transmits information over a wireless application service provider.

U.S. Patent No. 6,449,739 to Landan teaches post-deployment monitoring of

server performance using a controller that provides a user interface and various

functions for a user to remotely select agent computer(s) to include in a monitoring

session, assign attributes to such computers (such as the location, organization, ISP

and/or configuration of each computer), and assign transactions and execution

schedules to such computers, wherein the controller is hosted by an application

service provider.

Howstuffworks, "How ASPs Work" defines an ASP as an application or service

that is used by a particular business but owned by another business.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and

any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing

date of the advisory action. In no event, however, will the statutory period for reply

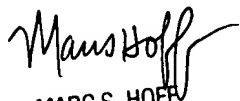expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jeffrey R. West whose telephone number is

(703)308-1309. The examiner can normally be reached on Monday through Friday,

8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Marc S. Hoff can be reached on (703)308-1677. The fax phone

numbers for the organization where this application or proceeding is assigned are

(703)308-7382 for regular communications and (703)308-7382 for After Final

communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is

(703)308-0956.

jrw
August 28, 2003

MARC S. HOFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800